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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,758	08/21/2003	Begum Tamer	1410-67551	8044
48940	7590	09/05/2007	EXAMINER	
FITCH EVEN TABIN & FLANNERY			CHAWLA, JYOTI	
120 S. LASALLE STREET			ART UNIT	
SUITE 1600			PAPER NUMBER	
CHICAGO, IL 60603-3406			1761	
MAIL DATE		DELIVERY MODE		
09/05/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/645,758	TAMER ET AL.	
	Examiner Jyoti Chawla	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 June 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 6 and 8-23 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 6 and 8-23 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6/22/2007</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

### **DETAILED ACTION**

Applicant's response filed June 22, 2007 has been entered. Claims 6, 8-23 are pending and examined in the application.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(A) Claims 6, 10-13, 16-17, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Negro (US 4629628) in view of the combination of Technology of biscuits, crackers and cookies, and of Dictionary of Food Ingredients.

The references and rejection are incorporated herein and as cited in the office action mailed March 23, 2007.

(B) Claims 8-9, 14-15 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Negro (US 4629628) in view of the combination of Technology of biscuits, crackers and cookies, and of Dictionary of Food Ingredients Industry as applied to claims 6, 10-13, 16-17, 20-23 above, further in view of Eiji Ito et al (JP05-316930). The references and rejection are incorporated herein and as cited in the office action mailed March 23, 2007.

(C) Claims 6, 8-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Negro (US 4629628) in view of the combination of Daggy (US 5955123), Technology of biscuits, crackers and cookies, and of Dictionary of Food Ingredients.

The references and rejection are incorporated herein and as cited in the office action mailed March 23, 2007

#### ***Response to Arguments***

Applicant's arguments filed June 22, 2007 have been fully considered but they are not persuasive.

I) Regarding applicant's argument that "Independent claim 6 is directed to a confectionary product that includes two outer wafer layers. The wafer layers are formed from a batter having specific components and ranges of components, which are effective for providing a *confectionary product that remains crunchy even upon continued chewing*. The combination of cited referenced do not teach one of ordinary skill which components to select and what amounts of each components to use to provide a *confectionary product that remains crunchy upon continued chewing*" (Remarks, page 6, item I), has not been found persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., components which are effective for providing a *confectionary product that remains crunchy even upon continued chewing*, Remarks, page 6) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

II) Applicant's arguments regarding Negro not teaching a wafer batter recipe with cocoa powder and lecithin in the recited range of the applicant (Remarks, page 7) have been considered and have not been found persuasive as the applicant has chosen to argue the references individually. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case the previous office action dated March 23, 2007 rejected applicant's claims 6, 8-23 in an obviousness rejection where the references teach that cocoa powder and lecithin in the range recited by the applicant were known to be used in making of wafers, biscuits and confectionary items. It was also noted that slight changes in the amounts of commonly used ingredients in a recipe does not constitute a patentable distinction (*In re Levin*, see above) absent any clear and convincing evidence and/or arguments to the contrary.

Similarly applicant's arguments regarding the Daggy reference (Remarks, pages 12-13) have also been considered and have not been found persuasive as the Daggy reference is relied upon in combination with the other references in an obviousness rejection.

Furthermore, applicant's arguments do not show unexpected properties that would result from the specific range of cocoa powder, lecithin etc., in the instantly claimed wafer composition, which would distinguish the product from the wafer product of the prior art. Furthermore, applicant argues that the ranges are critical, however, applicant has provided no evidence to support this argument, and thus applicant's argument appears to be based upon opinion and not factual evidence.

Further, attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in fact situation of the instant case. At page 234, the Court stated as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients, which produces a new, unexpected and useful function. *In re Benjamin D. White*, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

III). In response to applicant's argument that "The Dictionary reference discusses using cocoa to impart color and flavor only (page 37); there is no mention of it also being used to impart a crunchy texture" and further statement that "Therefore, no combination of these references would teach increasing the cocoa amount in a wafer to impart a crunchy texture," (Remarks, page 8) the applicant is reminded that the use of

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cocoa powder to impart crunchiness or crunchy texture as argued has not been recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

IV) Regarding applicant's argument about the viscosity of the batter, applicant is referred to Claim 12, which recites "A method for producing a wafer comprising blending a wafer batter with from 2 to 10% by weight cocoa powder to a viscosity as measured in a Ford cup like viscosimeter to a flow out time of at least 39 seconds at a temperature of 18 to 20°C."

Regarding applicant's argument that "Just because the Patent Office cannot physically measure the viscosity of the Negro batter, does not mean that it can then simply assume it to be equal to Applicants' viscosity." (remarks, page 8) has been fully considered however, as stated in the previous office actions that the burden is shifted to the applicant to show that the prior art product is different. As stated in the previous office action, since the liquids (water) and the solids content are the main determinants of the batter consistency, and since the wafer composition as taught by Negro has similar water content (thus similar solids content) as instantly claimed, one of ordinary skill in the art would expect that the batters taught by Negro would be comparable in consistency (viscosity) to the batter recited in the present invention. Furthermore, since Negro makes the wafers with similar proportion of ingredients as recited by the applicant and since the thickness of wafers taught by Negro falls within the recited parameters of the applicant, mere statement of measurement of viscosity of batter does not provide patentable distinction to the claims. Thus, the claimed invention would have been obvious over Negro, *absent any clear and convincing evidence and/or arguments to the contrary*. As of the current time, Applicant's response dated June 22, 2007 (Remarks, pages 8-9) states that viscosity of wafer taught by Negro is not similar to the viscosity of wafer batter of the invention and that the thickness of the batter is not the only indicator of the viscosity of the batter, however, the response is not persuasive as applicant has merely argued that the prior art (Negro) does not disclose viscosity and

does not offer any specific data, results of controlled experimentation, or other evidence to support that the viscosity of the Negro is unexpectedly different from the viscosity that is instantly claimed.

Furthermore, the applicant has not shown any evidence as to why it is critical that the product has a viscosity as recited in claim 12 and that the viscosity be specifically measured by "Ford cup like viscosimeter". Absent such specific evidence, it is the office's position that it would have been obvious to one of ordinary skill in the art at the time of the invention that the viscosity of the wafer batter as taught by Negro will be similar to the instantly claimed range. Furthermore, it would have been within the purview of one of ordinary skill at the time of the invention to modify the viscosity depending upon the thickness of the final wafer desired, the speed of baking, the mold or surface available for baking, the pourability of the batter desired etc., *absent any clear and convincing evidence and/or arguments to the contrary.*

V) Applicant's argument that the low moisture absorption as taught by Ito reference in the wafer is due to temperature of storage and not due to the amount of cocoa powder present in the wafer (Remarks, pages 9-10) has not been found persuasive. In response, the applicant is referred to the rejection in the previous office actions dated October 11, 2006 and March 23, 2007 where the argument has been responded. The applicant is also referred to Ito translation (Para 0016) where it is clearly stated that the cocoa powder used in making of the shell was responsible for low moisture absorption and retention of crunchy light texture of the ice cream filled cone as compared to the conventional wafer shell without added cocoa powder filled and stored in same environment. Thus applicant's argument that the crunchiness and low moisture absorbance of shell as taught by Ito is due to the temperature of storage and not due to the cocoa powder has not been found persuasive.

Regarding the amount of cocoa powder in the wafer composition as taught by Ito, applicant is referred to the previous office action dated October 11, 2006 which is

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incorporated herein and in the office action dated March 23, 2007. In the office action dated October 11, 2006, page 9, it was established that about 6% cocoa powder in the wafer composition as taught by Ito (Example 1, page 4 of Ito translation). Thus applicant's remark that the amount of cocoa powder cannot be determined as taught by Ito is not persuasive.

VI) In response to applicant's argument that there is no suggestion to combine the references (remarks, pages 10-13), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, for example, Ito reference teaches of a wafer composition with cocoa powder. The reference is also relied upon to show that wafer compositions with cocoa powder in the recited range of the applicant were known at the time of the invention. The reference has further been relied upon to show that wafers containing cocoa powder in the batter absorb less moisture and retain crunchy light texture more than the wafers made without the use of cocoa powder (Translation paragraph 0016). Regarding the fact that Ito teaches of making wafer cones for filling ice cream and not wafer stacks does not provide a patentable distinction to the wafer composition as claimed, absent any clear and convincing arguments and evidence to the contrary.

VII) In response to applicant's argument that it is not obvious to combine any of the references with Negro to obtain applicant's recited cocoa range (Remarks, pages 11-12), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have

suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the instant case the previous office actions and the remarks above have addressed that wafers with one of ordinary skill in the art at the time of the invention would have found the references.

Applicant's arguments submitted June 22, 2007, do not show unexpected properties that would result from the specific range of cocoa powder, lecithin and viscosity of the batter in the instantly claimed wafer composition, which would distinguish the product from the wafer product of the prior art. Furthermore, applicant argues that the ranges are critical, however, applicant has provided no factual evidence to support this argument, and thus applicant's argument appears to be based upon opinion and not factual evidence.

Applicant's arguments submitted June 22, 2007 have been fully considered and have not been found persuasive and the rejections are maintained for the reasons of record.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Chawla whose telephone number is (571) 272-8212. The examiner can normally be reached on 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jyoti Chawla  
Examiner  
Art Unit 1761



KEITH HENDRICKS  
PRIMARY EXAMINER